

Attorney's Docket: 2004DE183
Serial No.: 10101,777
Group: 1624

REMARKS

The Office Action mailed August 4, 2003, has been carefully considered together with each of the references cited therein. The remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

CLAIM STATUS

Claims 1-17 are pending in this Application. Claim 18 has been withdrawn from further consideration as being drawn to a non-elected invention.

Claim Rejection 35 USC § 103

Claims 1-17 stand rejected under 35 USC § 103(a) as being unpatentable over Kempfer et al. This rejection is respectfully traversed.

The Office states that Kempfer et al. "teach benzimidazolinedioxazines and in column 8, lines 39-43, disclose that separation of the compounds is difficult and the advantageous properties apply to the mixtures in which the mono- and dichlorinated products are also present." The Office concludes that "[o]ne would be motivated to prepare the present mixtures with the reasonable expectation of obtaining additional useful pigments."

Applicants' invention, as claimed, is directed to a mixed crystal and a process for preparing the same. As detailed in the specification, on page 2, paragraph [009]:

For the purposes of the present invention, the term mixed crystals also embraces solid solutions. The properties of the mixed crystals differ both from the properties of the individual components and from the properties of physical mixtures of the individual components. In particular, the x-ray powder diffraction patterns of the mixed crystals differ from the sum of the powder diffraction patterns of the individual compounds.

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In other words, Applicants' invention is directed to a mixed crystal, wherein the mixed crystal has a single crystal lattice structure encompassing two or more of the benzimidazolinedioxazine compounds employed.

In contrast, Kempfer et al. discloses the formation of compounds of formula (I), and discusses on column 8, lines 30-43, that the condensation reaction produces "a certain amount of monochloro and dichloro compound". Thus, in the composition of Kempfer et al., there is a compound of formula (I) and varying concentrations of monochloro and dichloro compounds. However, each of these compounds exists as a separate chemical entity having its own independent and distinct crystal lattice structure. In short, Kempfer et al. advances a physical mixture of the particular compounds.

It is Applicants' respectful position that the Office has not carried its burden of producing a *prima facie* case of obviousness. A *prima facie* case of obviousness requires the reference, or reference combination to disclose each and every element of a claim. Here, Kempfer et al. does not in anyway teach, disclose, or suggest a mixed crystal, but only a certain compound of formula (I) with monochloro and dichloro by products. Each of these constituents produces an independent crystal lattice structure and does not constitute a mixed crystal. A physical mixture, as the one disclosed by Kempfer et al., has quite different properties than a mixed crystal constructed of the same components and ratios. In consequence, Kempfer et al. can not provide the ordinary artisan with the requisite motivation to make mixed crystals of two or more benzimidazolinedioxazine compounds, nor does it disclose a method by which such mixed crystals can be synthesized.

In view of the foregoing, it is Applicants' courteous position that the Office has failed to carry its burden of advancing a *prima facie* case. Applicants therefore request reconsideration and withdrawal of the § 103 rejection.

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In view of the foregoing remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,


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